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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,063	07/30/2001	Eric R. Weber	DI-12	2551

7590 07/22/2002

Heska Corporation
Intellectual Property Dept.
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EXAMINER
LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 07/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/918063		
Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claim(s) 1-23 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

DETAILED ACTION

Location of Application

1. The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1634.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 and 10-12, drawn to an isolated nucleic acid molecule (1-3, 10, and 11) and a composition comprising an isolated nucleic acid molecule (claims 6 and 12), classified in class 536, subclass 23.1; a recombinant virus (claim 4), classified in class 435, subclass 91.33; a recombinant cell (claim 5), classified in class 435, subclass 252.3.

II. Claims 7-9 and 13-15, drawn to a method to produce a protein encoded by an isolated nucleic acid molecule, classified in class 435, subclass 69.1.

III. Claims 16-19, drawn to an isolated protein (claims 16-18) a composition comprising an isolated protein (claim 19), classified in class 530, subclass 350.

IV. Claims 20 and 21, drawn to an isolated antibody (claim 20) and a composition comprising an isolated antibody (claim 21), classified in class 424, subclass 130.1.

V. Claim 22, drawn to a method to detect an inhibitor of Tag1 activity, classified in class 435, subclass 7.1.

VI. Claim 23, drawn to a method to detect disease in an animal, classified in class 435, subclass 7.1.

3. The inventions are distinct, each from the other because of the following reasons:

Groups I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as using as a hybridization probe.

Groups I, III, and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, these different inventions are directed to different products have different modes of operation, different functions, or different effects and have different classifications.

Groups I and V are distinct and independent inventions in that they are directed to a product and an unrelated method. As a result, different and distinct searches will have to be performed. For example, the search required for Group I such as an isolated nucleic acid molecule of claim 1 is not required for Group V.

Groups I and VI are distinct and independent inventions in that they are directed to a product and an unrelated method. As a result, different and distinct searches will have to be performed. For example, the search required for Group I such as an isolated nucleic acid molecule of claim 1 is not required for Group VI.

Groups II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as using as an antigen to make an antibody.

Groups II and IV are distinct and independent inventions in that they are directed to a method and an unrelated product. As a result, different and distinct searches will have to be performed. For example, the search required for Group IV such as an antibody of claim 20 is not required for Group II.

Groups II and V are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group V such as a putative inhibitory compound of claim 22 is not required for Group II.

Groups II and VI are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will

have to be performed. For example, the search required for Group VI such as anti-canine Tag1 antibodies of claim 23 is not required for Group II.

Groups III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as using as an antigen to make an antibody.

Groups III and VI are distinct and independent inventions in that they are directed to a product and a unrelated method. As a result, different and distinct searches will have to be performed. For example, the search required for Group VI such as anti-canine Tag antibodies of claim 23 is not required for Group III.

Groups IV and V are distinct and independent inventions in that they are directed to a product and a unrelated method. As a result, different and distinct searches will have to be performed. For example, the search required for Group VI such as a putative inhibitory compound of claim 22 is not required for Group IV.

Groups IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §

806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as a western blotting assay.

Groups V and VI are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group VI such as immunocomplex of claim 23 is not required for Group V.

4. Sequence Election Requirement Applicable to All Groups

Each Group detailed above reads on patentably distinct SEQ ID Numbers. Each sequence is patentably distinct because the sequences are structurally unrelated sequences, and a further restriction is applied to each Group. Each sequence is patentably distinct because the sequences are structurally unrelated sequences, and a further restriction is applied to each Group. Although the nucleic acid and protein are related as the claimed nucleic acid is asserted to encode the claimed protein, they are distinct inventions because they are physically and functionally distinct chemical entities, and the protein product can be made by another and materially different process, such as by *in vitro* direct synthesis or purification from the natural source. Further, the nucleic acid may be used for processes other than the production of the protein such as using as a probe in a hybridization method. Therefore, applicant must further elect a single SEQ ID NO. (See MPEP 803.04). Applicant is advised that examination will be restricted to only elected SEQ ID NO. and should not to be construed as a species election.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.

Frank Lu
July 16, 2002